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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,331	03/16/2004	Lawrence D. Wong	10559-586002	3745
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FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER WILSON, SCOTT R	
			ART UNIT 2826	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,331

Applicant(s)

WONG, LAWRENCE D.

Examiner

Scott R. Wilson

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,13-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,13-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/16/2007 have been fully considered but they are not persuasive.

Claims 10, 19 and 25 are independent.

As to claim 10, applicant argues that the cited art, Edelstein et al. (US 2005/0194619)("Edelstein") discloses in paragraph [0022] a SiCOH material with dielectric constant exactly 3.0 and elastic modulus greater than 15 GPa. Applicant, however, does not expressly argue that the teachings of paragraph [0022] are not within the scope of claim 10. Applicant refers instead to Edelstein, paragraph [0023], which teaches a SiCOH film with dielectric constant about 2.5 and modulus greater than 5.0 GPa. Applicant points out that the disclosed range of modulus, 5.0 GPa or more, "includes moduli less than 11.5 GPa, which is beyond the scope of claim 10". Claim 10 claims a modulus range of 11.5 GPa or more. In fact, the range of more than 5.0 GPa does overlap the range of more than 11.5 GPa. 12 GPa, for example, is in both ranges. As to the modulus range taught by Edelstein paragraph [0022], namely more than 15 GPa, this range does overlap the range of more than 11.5 GPa. 16 GPa, for example, is in both ranges. As to dielectric constant, it is well-established in the Office that "3.0" and "less than about 3.0" are within the same scope. The word "about" suggests a range higher and lower than a central value.

As to claim 19, applicant points out that the hardness range of Edelstein is from 0.2 to about 2.0 GPa (paragraph [0071]). This overlaps the claimed hardness range of 1.9 GPa to 3.3 GPa. 2.0 GPa, for example, is in both ranges.

As to claim 25, applicant points out that the hardness range of Edelstein is from 0.2 to about 2.0 GPa. This overlaps the claimed hardness range of greater than 1.9 GPa. 2.0 GPa, for example, is in both ranges.

Claims 10 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. As to claim 10, Edelstein et al. discloses (paragraph [0022]) a carbon doped oxide (CDO) film with modulus greater than 15 GPa, which is within the scope of being about 11.5 GPa or greater. Edelstein, paragraph [0022], also teaches that the film has dielectric constant 3.0, which is within the scope of being "less than about 3.0".

As to claim 15, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

As to claim 16, Edelstein et al. discloses (paragraph [0022]) that the CDO film has a modulus greater than 15 GPa, which is within the scope of being in the range of about 20 GPa to about 25 GPa.

As to claim 17, Edelstein et al. discloses (paragraph [0022]) that the CDO film has a dielectric constant of 3.0.

As to claim 18, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Claims 19-21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. As to claim 19, Edelstein et al. discloses (paragraph [0071]) a carbon doped oxide (CDO) film with hardness up to 2 GPa, which is in the range of about 1.9 GPa to about 3.5 GPa.

As to claim 20, Edelstein et al. discloses (paragraph [0071]) that the CDO film has dielectric constant of 3.2.

As to claim 21, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

As to claim 23, Edelstein et al. discloses (paragraph [0071]) that the CDO film has dielectric constant of 3.2.

As to claim 24, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.. Edelstein et al. discloses (paragraph [0071]) a carbon doped oxide (CDO) film with hardness up to 2 GPa, which is in the range of about 1.9 GPa to about 3.5 GPa, and a modulus up to about 15 GPa.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein et al.. Although Edelstein et al. does not expressly disclose the density of the CDO film with modulus greater than 11.5 GPa, such a film would necessarily have a density in the claimed range. See MPEP 2112.01,

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 562 F.2d at 1255, 195 USPQ at 433. See also Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims were directed to a titanium alloy containing 0.2-0.4% Mo and 0.6-0.9% Ni having corrosion resistance. A Russian article disclosed a titanium alloy containing 0.25% Mo and 0.75% Ni **but was silent as to corrosion resistance**. The Federal Circuit held that the claim was anticipated because the percentages of Mo and Ni were squarely within the claimed ranges. The court went on to say that it was immaterial what properties the alloys had

or who discovered the properties because the composition is the same and thus must necessarily exhibit the properties.)."

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein et al.. As to claim 26, Edelstein et al. discloses (paragraph [0071]) a range of hardness up to about 2 GPa. Since there are no stated 1-sigma uncertainties, the upper boundary "about 2 GPa" can be considered to be within the claimed range of about 2.8 GPa to about 3.5 GPa. Likewise, Since there are no stated 1-sigma uncertainties, the disclosed (paragraph [0071]) upper range of modulus of Edelstein et al., about 15 GPa can also be considered to be within the claimed range of about 20 GPa to about 25 GPa. See MPEP 2144.05 on Obviousness of Ranges,

"In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" considered prima facie obvious in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms]." The court stated that "by stating that 'suitable protection' is provided if the protective layer is 'about' 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant's] claimed range."). **Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.** Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as

obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).”

As to claim 27, Edelstein et al. discloses (paragraph [0071]) that the dielectric constant of the CDO film is about 3.2.

As to claim 28, Edelstein et al., discloses (paragraph [0121]) that the CDO film is an interlevel dielectric.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott R. Wilson whose telephone number is 571-272-1925. The examiner can normally be reached on M-F 8:30 - 4:30 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Purvis can be reached on 571-272-1236. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

srw

/A. Sefer/
Primary Examiner
AU-2826